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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicants:	Jean-Luc Pous et al.	§	Art Unit:	3625
		§		
Serial No.:	10/043,856	§		
		§	Examiner:	Nicholas D. Rosen
Filed:	January 11, 2002	§		
		§		
Title:	Custom Engineered	§	Docket No.	22.1489
	Product System And	§		(SHL.0293US)
	Process	§		

Mail Stop **Appeal Brief-Patents**
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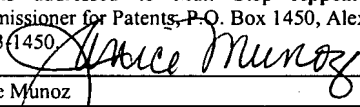
REPLY BRIEF

Dear Sir:

Applicant's Reply to the Examiner's Answer is set forth below.

- A. **Can Claims 42, 44, 45, 53 and 54 Be Rendered Obvious under 35 U.S.C. § 103(a) as being Unpatentable Over House (U.S. Patent No. 6,785,805) in View of the EMCORE article When the Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness?**

A *prima facie* case of obviousness requires a "clear articulation of the reason(s) why the claimed invention would have been obvious." 72 Fed Reg. 57526, 57528 (October 10, 2007) (herein called "the Notice"). Thus, mere conclusory statements will not support a case of obviousness. 72 Fed. Reg. at 57529. Applicant submits that this standard has not been met, as no reasoning has been set forth by the Examiner why obtaining market research using the selections of an unavailable product/attribute selector for a product/attribute that is not offered for sale would have been obvious in view of the cited references.

Date of Deposit: October 31, 2007
I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to Mail Stop **Appeal Brief-Patents**, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Janice Munoz

As pointed out in the Appeal Brief, the prior art fails to teach or suggest the claimed invention and for at least this reason, fails the teaching-suggestion-motivation test. The Examiner's untenable conclusion that "there is no question of the prior art failing to teach or suggest all of the limitations" (Examiner's Answer, 14) is specious, as neither the EMCORE article nor House discloses 1. using selections of selectors for an unavailable product/attribute as market research or 2. including a product/attribute selector in an online catalog for a product/attribute that is not offered for sale. Although the Supreme Court in *KSR International Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (U.S. 2007) held that the teaching-suggestion-motivation test is not the only test that may be applied for purposes of evaluating obviousness, the Examiner must still set forth a rationale that clearly articulates why the invention would have been obvious to one of skill in the art. 72 Fed. Reg. at 57528.

The Notice sets forth several rationales that may be relied on by the Examiner to support a case of obviousness. On pages 15 and 16 of the Examiner's Answer, the Examiner appears to be relying on the "obvious to try" rationale of choosing from a finite number of identified, predictable solutions to a recognized problem, with a reasonable expectation of success. *See, for example*, 72 Fed. Reg. at 57532. In particular, using the hindsight solely gleaned from the present invention, the Examiner contends that House purportedly presents a solution for obtaining market research and on this basis, concludes a case of obviousness. Examiner's Answer 15.

Applicant submits that the Examiner has not made at least one of the findings, which are required to support a case of obviousness based on the "obvious to try" rationale. In particular, in order to set forth a *prima facie* case of obviousness based on the "obvious to try" rationale, the Examiner must make the following findings: 1. "there has been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem"; and 2. "there has been a finite number of identified, predictable potential solutions to the recognized need or problem." 72 Fed. Reg. at 57532. The Examiner relies on the EMCORE article as purportedly setting forth the problem of market research, i.e., learning what customers want to buy. Examiner's Answer 15. However, the Examiner fails to explain how House discloses a solution to this problem.

In other words, no where does House set forth a solution to conduct market research using an online catalog or more specifically, selectors of an online catalog. The Examiner's rejections fail to bridge that gap. Thus, the Examiner has failed to clearly articulate reasons either through the "obvious to try" rationale or another rationale why it would have been obvious for one of skill in the art in view of House and the EMCORE article to conduct market research by including a selector in an online catalog for an unavailable product/attribute that is not offered for sale and observing the selections of the selector.

Additionally, House fails to disclose an unavailable product/attribute selector for an unavailable product or attribute that is not offered for sale, and the Examiner has failed to clearly articulate why such a selector would have been obvious to one of skill in the art. In this manner, House only describes selection of off-the-shelf components or components that are customized, or built to order. All of these selections are, however, for products that are offered for sale, contrary to the claim limitations.

Thus, the Examiner fails to clearly articulate why the claimed invention would have been obvious to one of skill in the art. The cited art merely discloses the need for market research and an online catalog that allows selections of off-the-shelf and custom made components. No reasoning has been set forth why one skilled in the art would have, in view of the cited art, 1.) incorporated an unavailable product/attribute selector for a product/attribute that is not offered for sale into an online catalog; and 2.) use selections of such a selector as market research. Therefore, Applicant maintains that the § 103 rejections of claims 42-55 are in error and should be reversed.

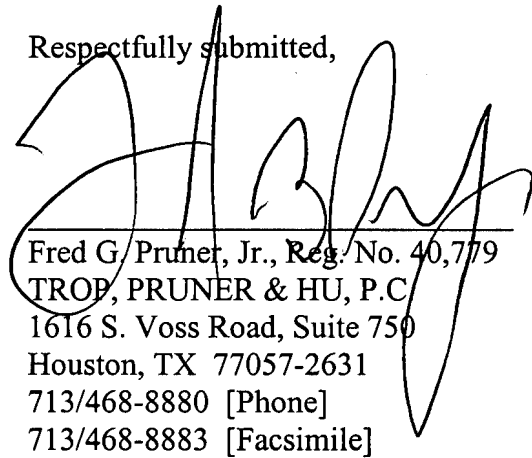
B. Can Claims 56, 57, 58 and 59 Be Rendered Obvious under 35 U.S.C. § 103(a) as being Unpatentable Over House (U.S. Patent No. 6,785,805) in View of the EMCORE article When the Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness?

For at least the same reasons set forth above, a *prima facie* case of obviousness has not been established for claim 56. In this regard, the Office Action fails to clearly articulate why a processor to compile selections made through a user interface that are not currently offered in a line of available products or attributes for purposes of market

research would have been obvious to one of skill in the art in view of House and the EMCORE article. Therefore, in view of the foregoing, Applicant maintains that the § 103 rejections of claims 56-62 are in error and should be reversed.

The Commissioner is authorized to charge any fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0293US).

Respectfully submitted,



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Date: October 31, 2007

APPENDIX OF CLAIMS

The claims on appeal are:

42. A method comprising:
providing an online catalog on a computer, the catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale;
and
using selections of unavailable products or attributes that are not offered for sale obtained via the unavailable product/attribute selector as market research to determine whether to extend a product offering that includes the unavailable products or attributes.
43. The method of claim 42, further comprising:
suggesting an existing/standard product based upon and as a replacement for the selection.
44. The method of claim 42, further comprising:
determining a resource cost for the unavailable product/attribute.
45. The method of claim 42, further comprising:
assigning a category of design requirements to the unavailable product/attribute.
46. The method of claim 45, further comprising:
determining a resource cost for the unavailable product/attribute;
assigning a first category to the unavailable product/attribute if the resource cost is relatively lower;
assigning a second category to the unavailable product/attribute if the resource cost is relatively higher.
47. The method of claim 45, further comprising:
transmitting a request for the unavailable product/attribute to an address associated with the assigned category.

48. The method of claim 47, further comprising:
transmitting the request to a manufacturing facility for the unavailable product/attribute if it is assigned to a first predefined category.

49. The method of claim 47, further comprising:
transmitting the request to an engineering department for the unavailable product/attribute if it is assigned to a second predefined category.

50. The method of claim 42, further comprising:
providing a list of available products in the online catalog.

51. The method of claim 50, further comprising:
obsoleting an available product by moving it from the list of available products to a list of unavailable products.

52. The method of claim 42, further comprising:
receiving an order of an available product and transmitting a request to a manufacturing facility.

53. The method of claim 42, wherein the unavailable product/attribute selector comprises a list of unavailable products/attributes.

54. The method of claim 53, further comprising:
classifying an item in the list of unavailable products/attributes.

55. The method of claim 42, wherein the unavailable product/attribute selector comprises an online form.

56. A system comprising:

a user interface selection device in communication with the processor, the user interface selection device adapted to display a list of products or attributes that are not currently offered in a line of available products or attributes from a provider; and

a processor to compile selections made through the user interface of the available products that are not currently offered in a line of available products or attributes, the compilation of selections to be used as market research for a decision of whether to extend a product offering to include the list of products or attributes.

57. The system of claim 56, wherein the processor stores in a memory of the system a list of unavailable products/attributes.

58. The system of claim 57, wherein the processor displays the list of unavailable products/attributes on a visual interface of the system.

59. The system of claim 57, wherein the processor stores in a memory of the system a category of design requirements associated with the unavailable products/attributes.

60. The system of claim 56, wherein the processor is adapted to receive a selection of an unavailable product/attribute via a selection signal from a user interface selection device of the system; and

display a resource cost of the unavailable product/attribute on a visual interface of the system.

61. The system of claim 56, wherein the processor is adapted to receive a selection of an unavailable product/attribute via a selection signal from a user interface selection device of the system; and

identify, by a CPU of the system, one or more available products, from the list of available products, that has similar characteristics to those of the selected unavailable product/attribute; and

display the identified one or more available products on a visual interface of the system.

62. The system of claim 56, wherein the processor is adapted to generate a specification for a product in response to receiving, by a CPU of the system, a selection signal from the user interface selection device of an unavailable product/attribute.